

REMARKS

Claims 1-31 are pending. Applicants express appreciation to the Examiner for having carefully read each of the pending claims. As indicated above, claims 5, 6, 8, 12, 16, 19, 20, 27, and 30 have been amended to correct the informalities noted in the Office Action. In correcting these informalities, Applicants specifically note that none of the amendments narrow the scope of the claims or otherwise evince an intent to surrender any subject matter.

With respect to claim 4, the Office Action states that the claim "recites 'the object to deleted' instead of 'the object to be deleted'" whereas in fact the claim correctly recites "that the object be deleted" and therefore claim 4 has not been amended. With respect to claims 7 and 29, the Office Action states that the claims "recite 'the store register' instead of 'a store register.'" Applicants note that "the store" has antecedent basis in claim 6 and the preamble of claim 1, and that the word "register" in claims 7 and 29 is used as a verb (rather than a noun), and therefore claims 7 and 29 have not been amended.

The Office Action rejected claims 1-31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,052,735 to Ulrich et al. ("Ulrich") in view of U.S. Patent No. 6,324,544 to Alam et al. ("Alam"). The Office Action also rejected claim 11 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Application No. 09/775,953 (this application), and U.S. Patent No. 6,324,544 to Alam et al. were, at the time the invention of Application No. 09/775,953 owned by or subject to an obligation of assignment to Microsoft Corporation. Therefore, in accordance with 35 U.S.C. § 103(c), Alam is disqualified as 35 U.S.C. § 102(e) prior art.¹ (Applicants' filed on February 2, 2001, which is on or after November 29, 1999, and Alam issued November 27, 2001.) See MPEP § 702.02(l). Accordingly, the rejections of record under 35 U.S.C. § 103(a) for all pending claims should be withdrawn.

The Office Action asserts that claim 11 is "indefinite in that it fails to point out what is included and excluded by the claim language with the use of the phrase: 'may be deleted from the store' in lines 19 and 20" and that the claim is an omnibus type claim. See Office Action, p. 3 (rejection of claim 11). Applicants respectfully disagree. Claim 11 recites "receiving a soft

¹In disqualifying Alam, Applicants do not acquiesce to any of the teachings of the cited art that are asserted in the Office Action—it is simply unnecessary to address those assertions at this time. Accordingly, Applicants reserve the right to challenge any of the Office Action's assertions in the future, should such challenges become necessary or desirable.

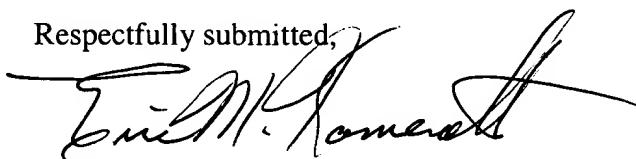
delete request from a first synchronization partner." As described in the Specification beginning on page 14 at line 22, a filter often used during synchronizations identifies objects or other data that no longer require synchronization and therefore may be deleted. *See MPEP § 2173.02* ("Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made."). The soft delete request recited in claim 11 informs the device sync module that an object is excluded by a filter and therefore may be deleted from the store of the device. Whether and when the deletion occurs is irrelevant to informing the device sync module that the deletion is permitted. Accordingly, Applicants respectfully submit that claim 11 satisfies the requirements of 35 U.S.C. § 112, second paragraph, and any rejection to the contrary is improper and should be withdrawn.

Applicants fail to see the ambiguity alleged in the Office Action and note that "[i]f upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is 'vague and indefinite' should be included in the Office Action." MPEP § 2173.02 (emphasis added). Applicants also point out that claim 11 does not, in any degree, resemble an omnibus claim as described in MPEP § 2173.05(r) and request further explanation should the Examiner maintain this rejection in the next Action.

In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 5th day of April, 2004.

Respectfully submitted,



RICK D. NYDEGGER
Registration No. 28,651
ERIC M. KAMERATH
Registration No. 46,081
Attorneys for Applicant
Customer No. 022913

KCS0000001000V001